

REMARKS

At the time the current Official Action was mailed, claims 1-18 were pending. The Examiner rejected claims 1-18. The Applicants have amended claims 1-13, have cancelled claims 14-18, and have added new claims 19-28. The amendments and new claims do not add any new matter. In view of the foregoing amendments and the following remarks, the Applicants respectfully request reconsideration and allowance of all pending claims.

Rejections under 35. U.S.C. § 102

The Examiner rejected claims 1, 4 and 5-7 under 35 U.S.C. § 102 (b) as being anticipated by McConville (U.S. 5,826,277), claims 8-12 under 35 U.S.C. § 102 (b) as being anticipated by Smith (U.S. 4,977,011), and claims 14-18 under 35 U.S.C. § 102 (b) as being anticipated by Sullivan (U.S. 4,856,116).

The Applicants respectfully traverse these rejections. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims

recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

Turning to the claims, the present independent claims 1 and 8 both recite the element “a sensor coupled to the headband on a patient side of the elastic segment.” Independent claim 19 recites the element “wherein the nonelastic segment has less slack when the elastic segment is applied to a patient’s head with sufficient tension to deliver pressure in the range higher than venous pressure and lower than capillary pressure to the wearer’s head.”

Addressing the cited references as applied to independent claims 1 and 8, the McConville, Smith, and Sullivan patents do not disclose or suggest a headband coupled to a sensor of any sort. In particular, the Examiner has stated that the Sullivan reference teaches a headband for holding an oximetry sensor on the forehead. The Applicants traverse this characterization of the Sullivan reference and invite the Examiner to specifically point to where the Sullivan reference teaches a headband coupled to an oximetry sensor. Similarly, neither the McConville nor the Smith reference recites a headband coupled to a sensor. Because the McConville, Smith, and Sullivan references fail to disclose all of the elements of independent claims 1 and 8, the cited references are sufficient to support a rejection of pending claims 1-13 and 25-27 under 35 U.S.C. 102(b).

Turning to new independent claim 19, the McConville, Smith, and Sullivan patents do not disclose or suggest a headband including a nonelastic segment that has decreased slack when the headband is applied to a patient's head with sufficient tension to deliver pressure in the range higher than venous pressure and lower than capillary pressure to the wearer's head. Accordingly, independent claim 19, as well as all claims depending therefrom, are not anticipated by the McConville, Smith, and Sullivan references.

Turning to new independent claim 28, the McConville, Smith, and Sullivan patents do not disclose or suggest a headband including a non-elastic segment that is attached on an exterior side of the elastic segment in such a manner that the non-elastic segment projects out from the surface of the elastic portion when the headband is not sufficiently tight, thus creating a loop which provides a visual indication that the headband needs re-tightening. In particular, the Applicants would like to note that the McConville reference recites a sweat band with a sponge layer for increased sweat absorption. The sponge layer is pulled against the elastic sweat band when the band is pulled across the wearer's head. As the sponge area as recited in the McConville reference is for the purpose of absorbing sweat produced by the forehead, it is clear that a configuration in which the sponge portion were on the exterior surface of the band, not touching the forehead, would not serve the purpose of absorbing sweat. As recited in independent claim 28, a nonelastic portion is positioned on the exterior of the elastic band so that slackness in the nonelastic portion serves as an indication to an observer that the band should be tightened. Accordingly, independent claim 28 is not anticipated by the McConville, Smith, and Sullivan references.

While not necessarily agreeing with the other assertions in the 35 U.S.C. § 102 rejection about what the cited references disclose, in view of the Examiner's failure to cite any teaching of the above-mentioned claim features, no specific comment on the other assertions is deemed necessary.

Rejections under 35 U.S.C. § 103

The Examiner rejected claims 2 and 3 under 35 U.S.C. § 103(a) as being unpatentable over McConville (5826277) in view of German patent document 295 15 977.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must

suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

The rejection of claims 2 and 3 under Section 103 is defective for at least the reasons set forth above with respect to the rejection of independent claim 1 under Section 102. Neither McConville nor German patent document 295 15 977 discloses a headband coupled to a sensor. Accordingly, the combination of McConville with German patent document 295 15 977 cannot render the Applicants' claims obvious. Therefore, the Applicants respectfully assert that the rejections of claims 2 and 3 under Section 103 should be withdrawn.

While not necessarily agreeing with the other assertions in the 35 U.S.C. § 103 rejections, including but not limited to the allegations as to what would be obvious to one with skill in the art, in view of the Examiner's failure to cite any teaching of the above-mentioned claim feature, no specific comment on the other assertions is deemed necessary.

Conclusion


In view of the remarks set forth above, the Applicants respectfully request reconsideration of the Examiner's rejections and allowance of all pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

General Authorization for Extensions of Time

In accordance with 37 C.F.R. § 1.136, the Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request therefor. Furthermore, the Applicants authorize the Commissioner to charge the appropriate fee for any extension of time to Deposit Account No. 06-1315; Order No. TYHC:0127/FLE/BAK.

Respectfully submitted,

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